

## **REMARKS**

Prior to entry of this Amendment:

Claims **1 – 34, 36 – 56 and 65 – 74** were pending in the present application

Claims **1 – 34, 36 – 56 and 65 – 74** stand rejected

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

Claims **1 – 34, 36 – 56, 69, 70, and 75-79** will be pending

Claims **1, 28, and 69** will be amended

Claims **65-68 and 71-74** will be cancelled

Claims **75-79** will be added

Claims **1, 69, 76, 78 and 79** will be the only independent claims

### **A. RCE**

This Amendment and Response is being filed in response to a Final Office Action. A Request for Continued Examination (RCE), along with the appropriate fee, is being filed concurrently to ensure consideration of this Amendment and Response.

### **B. Claim Amendments**

#### **B.1. Claim 28 has been amended to correct a minor typographical error**

During a review of the file, we noticed that Claim **28** was missing a period at the end of the sentence. This error has been corrected.

#### **B.2. Claims 65-68 and 71-74 have been cancelled**

Although we do not necessarily agree with the Examiner's rejection of Claims 65-68 and 71-74, those claims have been canceled without prejudice. We submit that Claims 65-68 and 71-74 contain allowable subject matter, and that Claims 65-68 and 71-74 have been canceled solely in order to expedite issuance of the present application. We intend to pursue the subject matter of the canceled claims in a continuing application.

**B.3. Independent Claim 1 has been amended**

Although we do not necessarily agree with the Examiner's rejection of Claim 1, it has been amended without prejudice. The amendment is discussed below. We submit that Claim 1 contains allowable subject matter. We intend to pursue the subject matter of Claim 1, as originally filed and / or previously presented, in a continuing application.

**B.4. The preamble of Claim 69 has been amended**

We have removed the reference to "for selling an aging food product" in the preamble of Claim 69. No new matter has been added. We submit that Claim 69 is in condition for allowance.

**C. Section 102(b) Rejection**

Claims 1-17, 20, 22-28, 36-39, 41-44, 47, 48, 50-56 and 65-74 stand rejected under 35 U.S.C. § 102(b) as being anticipated by [www.cryobank.com](http://www.cryobank.com). We respectfully traverse the Examiner's Section 102(b) rejection.

Claims 65-68 and 71-74 have been cancelled without prejudice.

**C.1. Independent Claims 1, 69 and 70**

Although we do not necessarily agree with the Examiner's § 102(b) rejection, independent Claim 1 has been amended and now recites (emphasis added):

1. (CURRENTLY AMENDED) A process, comprising:  
receiving information identifying a product;  
identifying at least a first retailer offering the product; and  
determining, by a controller, terms of a subscription for the product, wherein the subscription is valid at the at least first retailer,  
wherein the terms indicate that a customer is required to make a plurality of purchases of the product during a duration of the subscription,  
each purchase of the plurality of purchases being for one or more units of the product,  
each purchase of the plurality of purchases occurring during a respective visit to the at least one retailer, and

wherein the terms include a penalty to be assessed against the customer if the customer violates one or more terms of the subscription.

We respectfully submit that Claim 1 is not anticipated by www.cryobank.com. www.cryobank.com does not teach or suggest all of the features of independent Claim 1.

There is no hint in www.cryobank.com that a customer is required under a subscription to make a plurality of purchases of any product during a subscription.

Further, there is no hint in www.cryobank.com that a customer is required under a subscription to make each of the required plurality of purchases during a respective visit to a retailer.

The Examiner interprets the “purchase & store” programs of www.cryobank.com as teaching a subscription.

Although we do not necessarily agree with the Examiner, we submit that the “purchase & store” programs do not suggest a subscription in which *a plurality of purchases is required*. For instance, a customer of www.cryobank.com seems always to be able make whatever number of purchases he chooses in the “purchase & store” program. Thus, there is no suggestion that the customer is required by any term of a “purchase & store” program to make a plurality of purchases.

Further, contrary to the Examiner’s implication, there is no suggestion that the customer must ever visit the storage facility under the terms of the “purchase & store program.” As indicated by the Examiner, “client pickup” is an “option,” not a requirement. The cited materials clearly indicate that stored specimens may be shipped to the buyer. Thus, there is no suggestion of a program in which a buyer is obligated by any term of the program to visit any retailer.

Further still, there is no hint in www.cryobank.com of any requirement of a subscription that each required purchase be during a respective visit to the facility.

In contrast, some embodiments of the present invention provide for wherein a subscription established for a customer requires, for example, that the customer purchase at least one unit of a product each week for a year at a retailer. [See, *e.g.*, Specification, page 29, lines 11-16].

There is no suggestion in www.cryobank.com of the desirability of having a customer be required by a term of a subscription to make multiple visits to a retailer and / or to make multiple purchases. In fact, www.cryobank.com suggests that a customer need never visit the facility at all, but may simply have purchased specimens shipped to him.

Independent Claims **69 and 70** recite apparatus and computer-readable medium, respectively, providing the functionality of Claim 1. Thus, we submit that Claims 1 (and claims 2-17, 20, 22-28, 36-39, 41-44, 47, 48, 50-56), **69 and 70** contain allowable subject matter. We respectfully request withdrawal of the Section 102(e) rejection.

### **C.2. Claim 25**

The Examiner has not provided any evidence of a feature *wherein the price decreases progressively per unit of product purchased during the duration of the subscription*.

www.cryobank.com does not suggest any such feature, and the Examiner does not assert otherwise.

A *prima facie* case of anticipation requires substantial evidence of record that such a feature would have been known. No evidence has been provided. Accordingly, no *prima facie* case of anticipation has been made for Claim 25. We respectfully request withdrawal of the anticipation rejection of Claim 25.

### **C.3. Claims 37 and 38**

The Examiner has not provided any evidence of a feature *wherein the penalty is assessed against the customer if the customer fails to comply with a term identifying any of:*

*a subscription frequency (Claim 37); or*

*the subscription duration (Claim 38).*

The Examiner asserts only that www.cryobank.com “shows fees for changes and cancellations (penalty assessed for customer violation of terms).” [page 2]. This does not suggest a penalty in any way related to a frequency or a duration. In fact, the indicated fees are explicitly “charged if cancellation or change of order is made on the same day of shipment, or if order is changed more than one time.” [www.cryobank.com].

Some embodiments of the present invention provide for a frequency term of a subscription. For example, a retailer may require that individual products be purchased on a weekly or monthly basis. [See, e.g., Specification, page 13, lines 3-6; FIGs. 5, 6; page 16, lines 11-16; page 28, lines 14-16; page 29, lines 1, 11-14].

The Examiner has not provided any explanation as to why cancellation or change of order suggests a term of a subscription identifying a frequency of the subscription or a duration of the subscription.

www.cryobank.com does not suggest a penalty in any way related to a *subscription frequency* or a *subscription duration*. Accordingly, no *prima facie* case of anticipation has been made for Claims **37 and 38**. We respectfully request withdrawal of the anticipation rejection of Claims **37 and 38**.

**C.4. Claim 52**

The Examiner has not provided any evidence of features of:  
*recording product purchase information on a customer device;*  
*comparing the product purchase information with terms of the subscription stored on the customer device; and*  
*updating subscription information on the customer device*  
as recited in Claim **52**.

www.cryobank.com does not suggest *a customer device*, recording information on a customer device, or updating information on a customer device, and the Examiner does not assert otherwise.

A *prima facie* case of anticipation requires substantial evidence of record that such a feature would have been known. No evidence of the above features has been provided. Accordingly, no *prima facie* case of anticipation has been made for Claim **52**. We respectfully request withdrawal of the anticipation rejection of Claim **52**.

**D. Section 103(a) Rejection**

Claims 18, 29, 21, 29-34, 40, 45, 46, or 49 stand rejected under 35 U.S.C. 103(a) as being unpatentable over:

www.cryobank.com, and

asserted subject matter for which no evidence has been provided (the Examiner's "Official Notice").

We respectfully traverse the Examiner's Section 103(a) rejection. The Examiner has not provided any evidence that the asserted features and motivations were known, much less substantial evidence.

**D.1. Substantial evidence of findings is required**

Factual findings are upheld unless they are unsupported by substantial evidence. In re Gartside, 203 F.3d 1305, 1316 (Fed. Cir. 2000). Substantial evidence is "such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." Consol. Edison Co. v. NLRB, 305 U.S. 197, 229-30, 83 L. Ed. 126 (1938).

In order to make a *prima facie* case of obviousness, the Examiner is thus required to provide substantial evidence of asserted findings of fact underlying the rejections. Accordingly, the Examiner is required to provide substantial evidence of both:

- (i) asserted teachings of the prior art, and
- (ii) asserted motivations to combine teachings from different references.

**D.2. No substantial evidence of findings is provided**

The Examiner has not provided any evidence in support of any of the Section 103(a) rejections of Claims 18, 19, 21, 29-34, 40, 45, 46, or 49.

**D.2.a. Claims 18, 19 and 21**

The Examiner concedes that www.cryobank.com does not teach all of the features of Claims 18, 19 and 21. [page 3]

The Examiner asserts: "it is old and well known that many medical offices have more than one office in order to make more money by being more available to customers."

No evidence is provided in support of this asserted finding. Thus, the Examiner has failed to provide substantial evidence of either:

*a plurality of retailers, or*

a motivation to modify www.cryobank.com to provide for *a plurality of retailers*.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of Claims **18, 19, or 21**. We request that the Section 103(a) rejection of Claims **18, 19 and 21** be withdrawn.

**D.2.b. Claims 29-34, 40, 45, 46 and 49**

The Examiner concedes that www.cryobank.com does not teach all of the features of Claims **29-34, 40, 45, 46 and 49**. [page 4]

The Examiner asserts: “it is old and well known that many professional offices outsource accounting and payment functions in order to focus more on the profession instead of the business.”

No evidence is provided in support of this asserted finding. Thus, the Examiner has failed to provide substantial evidence of either:

- *wherein the terms include information identifying a total price and wherein the customer pays the total price to a controller (Claim 29),*
- *wherein the customer pays the total price to the controller at the end of the subscription (Claim 30),*
- *wherein the customer pays the total price to the controller when establishing the subscription (Claim 31),*
- *wherein the terms include information identifying: a total subscription quantity; a subscription price, a subscription frequency; and the subscription duration (Claim 32),*
- *wherein the subscription price is based on at least one of: the total subscription quantity; the subscription frequency; and the subscription duration (Claim 33),*
- *wherein the terms further include information identifying a subscription start date and a subscription end date (Claim 34),*
- *wherein the penalty is assessed against the customer by applying a penalty against a frequent shopper account (Claim 40),*
- *wherein tracking fulfillment is performed by a controller (Claim 45),*

- *wherein tracking fulfillment further comprises:*
  - receiving, from the at least first retailer, a transaction authorization request, the transaction authorization request including information identifying a redemption identifier and a product;*
  - determining, based on the redemption identifier, whether the subscription is valid;*
  - determining if the product may be redeemed under the subscription;*
  - and*
  - communicating an authorization of the transaction to the at least first retailer if the subscription is valid for the product (Claim 46), or*
- *receiving a request from the at least first retailer requesting an authorization of a transaction involving the customer and a product; and authorizing the transaction if the customer is complying with terms of the subscription (Claim 49)*

**or**

a motivation to modify www.cryobank.com to provide for any of the above features.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of Claims **29-34, 40, 45, 46 and 49**.

In addition, even if the asserted motivation (“outsource accounting and payment functions in order to focus more on the profession instead of the business”) was supported by substantial evidence (which it is not), it would not have motivated one of ordinary skill in the art to make all of the modifications of www.cryobank.com proposed by the Examiner. For instance, it does not appear from the Examiner’s brief statement that “outsourcing” has anything to do with:

the information included in the terms of a subscription (Claims **32 and 34**),  
what a subscription price is based on (Claim **33**), or  
applying a penalty to a frequent shopper account (Claim **40**).

We request that the Section 103(a) rejection of Claims **29-34, 40, 45, 46 and 49** be withdrawn.

For at least the reasons stated herein, we respectfully request allowance of Claims **1 – 34, 36 – 56, 69, and 70**.



**E. Newly-Added Claims 75-79 Are Patentable Over the Cited References**

Newly-added Claims **75-79** are patentable over www.cryobank.com.

Claim **75** is dependent on Claim **1** and recites a feature in which at least one of the at least first retailer is a supermarket. Nothing in www.cryobank.com would suggest a supermarket.

New independent Claims **76, 78 and 79** contain allowable subject matter. www.cryobank.com does not suggest features of:

- identifying at least one supermarket offering the product;
- establishing, by a controller, terms of a subscription for the product,
  - in which the subscription is valid at the at least one supermarket,
  - in which the terms include information identifying:
    - a subscription price, in which the subscription price is less than a retail price of a unit of the product,
    - a frequency of the subscription that indicates a period of time,
    - a duration of the subscription, in which the duration of the subscription includes at least two of the periods of time, and
    - in which in order to comply with the frequency of the subscription the customer is required to purchase at least one unit of the product in each of the at least two periods of time;
- determining whether the customer is complying with the frequency of the subscription; or
- authorizing the customer to purchase the product at the subscription price if the customer is redeeming the product in accordance with the frequency.

Some embodiments of the present invention provide for a frequency term of a subscription. For example, a retailer may require that individual products be purchased on a weekly or monthly basis. Thus, some embodiments of the present invention provide for wherein a subscription established for a customer requires, for example, that the customer purchase a unit of a product each week for a year at a retailer. [See, *e.g.*, Specification, page 13, lines 3-6; FIGs. 5, 6; page 16, lines

11-16; page 28, lines 14-16; page 29, lines 1, 11-14]. Thus, compliance with terms of the subscription may require that a customer visits a retailer and makes a purchase in each period of time indicated by the frequency (*e.g.*, each week) during the duration of the subscription (*e.g.*, a year).

According to Claim 76, a customer is required under the terms of the subscription to make a purchase in each of at least periods of time (*e.g.*, each week) during the duration of the subscription. Nothing in www.cryobank.com remotely suggests any such requirement, much less *determining whether the customer is complying with the frequency of the subscription*.

Further, nothing in www.cryobank.com suggests *a subscription price that is less than a retail price of a product, or identifying a supermarket offering the product*, as generally recited in Claim 76.

Claims 78 and 79 provide for apparatus and computer readable medium providing the functionality of Claim 76. Claim 77 depends from Claim 76.

For at least the reasons stated herein, we respectfully submit that new Claims 75-79 are allowable.

**F. Conclusion**

It is submitted that all of the pending claims (Claims 1 – 34, 36 – 56, 69, 70, and 75-79) are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mtdowns@walkerdigital.com](mailto:mtdowns@walkerdigital.com).

If any additional extension of time is necessary, please grant a petition for the extension of time required to make this Response timely. Additionally, please charge any appropriate fees necessary for this response and application.

**Charging information:**

Deposit Account: 50-0271

Order No.: 99-077

Please credit any overpayment to the same account.

*A duplicate copy of this authorization is enclosed for such purposes.*

December 6, 2004  
Date

Respectfully submitted,



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**F. Conclusion**

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